

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THERESA A. BRASSEY

Appeal No. 2000-2223
Application No. 09/040,271

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 and 2. No other claims are currently pending.

Appellant invention pertains to a reversible jacket for displaying alternative team and/or player affiliations. The appealed claims are reproduced in the "Appendix" section of appellant's brief.

Appeal No. 2000-2223
Application No. 09/040,271

The references applied in the final rejection are:¹

Loscher 2,711,539 June 28, 1955
"Eastbay Catalog", Pro Player Youth Home Away Jackets,
pg. 36, (Spring 1996).

The claims on appeal stand finally rejected under 35 U.S.C.
§ 103 as being unpatentable as follows:

- (1) claims 1 and 2, unpatentable over Loscher;
- (2) claims 1 and 2, unpatentable over the Eastbay Catalog.

Reference is made to appellant's brief (Paper No. 8) and to the examiner's answer (Paper No. 9) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Opinion

Before considering the merits of the standing rejections, we must determine the scope of the claims, and in particular, the "visible indicia" limitations of the claims. Consistent with appellant's specification (page 4, lines 3-15) and arguments (brief, page 12, lines 5-29), we interpret the language "visible indicia so as to identify a sports team" appearing in claim 1 to

¹It also appears that the standing rejections are based, at least in part, on the examiner's taking of Official Notice "that it is well known that teams and players have specific team colors which represent a sports team/players" (answer, page 4).

mean "visible name, symbol and/or logo that a sports fan would readily associate with a particular sports team, but not merely the color or combination of colors typically worn by said sports team during competition." Consistent with appellant's specification (page 4, lines 10-13) and arguments (brief, page 5, lines 1-5), we interpret the language "visible indicia so as to identify a sports player" appearing in claim 2 to mean "visible name and/or jersey number of a sports player."

Turning next to the issue of the weight to be accorded the "visible indicia" limitations of claims 1 and 2, these limitations are directed to printed matter. The printed matter "visible indicia" of claim 1 comprises visible indicia identifying a sports team on each of the inner and outer surfaces of the reversible jacket, with the visible indicia on the inner surface being of a different team affiliation than the visible indicia on the outer surface of the jacket. The printed matter "visible indicia" of claim 2 comprises visible indicia identifying a sports player on each of the inner and outer surfaces of the reversible jacket, with the visible indicia on the inner surface being of a different player than the visible indicia on the outer surface of the jacket.

The appropriate test for determining whether printed matter limitations are entitled to patentable weight is set forth in *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983), wherein the court stated:

[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.

* * *

What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. [Italics in original, underlining added for emphasis; footnotes omitted.]

In *Gulack*, the court concluded that the claimed printed matter should be given patentable weight because there was a functional relationship between the printed matter and the substrate, in that the printed matter was an endless sequence of digits and the substrate was an endless band, such that the band "present[ed] the digits as an endless sequence with no discrete beginning or end." *Gulack*, 703 F.2d at 1382, 217 USPQ2d at 402. Thus, the endless nature of the printed matter exploited the endless nature of the substrate.

In the present case, independent claim 1 is directed to a jacket of reversible construction having an inner surface and an outer surface, and visible indicia identifying a sports team on each surface of the jacket, wherein the indicia on the inner surface is for a different team than the indicia on the outer surface. Claim 2 is similar except that the visible indicia relates to sports players rather than sports teams. We hold that the functional relationship between the claimed substrate (jacket of reversible construction having inner and outer surfaces) and the claimed printed matter (visible indicia identifying *different* sports teams or sports players, with each jacket surface carrying indicia identifying a *different* team or player) is the sort of functional relationship that requires the printed matter to be given patentable weight in that the different sports team or player nature of the printed matter exploits the reversible construction of the jacket.

In light of the above, it should be apparent that we do not agree with the examiner's position on pages 5-6 of the answer to the effect that the "visible indicia" limitations of the appealed claims constitute printed matter limitations of the type that are to be accorded no weight in determining the patentability of the claimed subject matter.

Looking at the prior art references applied against the appealed claims, the Loscher reference, in pertinent part, is directed to a reversible jacket "constructed with an outer fabric and a different inner fabric which may be of a color to harmonize or contrast with the color of the outer fabric" (column 3, lines 50-53). In addition, the outer fabric may have a different texture than the inner fabric (column 5, lines 10-18). The colors or patterns of the surfaces of Loscher's jacket are not disclosed as being affiliated with sports teams or sports players of any sort, much less different sports teams or sports players. The Eastbay Catalog reference discloses in the lower right hand corner a reversible jacket for displaying a sports team affiliation, with one surface displaying "home" colors and the other surface displaying "away" colors; however, the team affiliations on the inner and outer surfaces are for the same sports team. The examiner has not adequately explained, and it is not apparent to us, where the cited references teach providing visible indicia identifying *different* teams or *different* players on the inner and outer surfaces of the same reversible jacket. In addition, it is not apparent to us how the examiner's taking of Official Notice "that it is well known that teams and players have specific team colors which represent a sports team/players" (answer, page 4)

would have suggested to one of ordinary skill in the art that the reversible jackets of Loscher and/or Eastbay Catalog may be modified in a manner that would result in the subject matter of claims 1 or 2. In this regard, we disagree with the examiner's position on page 5 of the answer to the effect that the differences between the reversible jackets of the applied references and the appealed claims are merely obvious matters of design choice.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In making such rejections, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. In the present case, the examiner has failed to advance any factual basis to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the reversible jackets of Loscher or Eastbay Catalog in a manner that would result in the subject matter of claims 1 or 2. The mere fact that the prior art references could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (see *In re Gordon*,

Appeal No. 2000-2223
Application No. 09/040,271

733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Neither Loscher nor Eastbay Catalog contains any such suggestion.

Accordingly, we shall not sustain either of the standing 35 U.S.C. § 103 rejections of claims 1 and 2.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

LJS/lp

Appeal No. 2000-2223
Application No. 09/040,271

JOHN P HALVONIK
806 WEST DIAMOND AVENUE
SUITE 301
GAITHERSBURG, MD 20878

Lettie

JUDGE STAAB

APPEAL NO. 2000-2223

APPLICATION NO. 09/040,271

APJ STAAB

APJ ABRAMS

APJ NASE

DECISION: **REVERSED**

PREPARED: Sep 15, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK